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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Samuel Eak Hua Nguy et al.

Serial No.: 10/757,019

Filed: January 14, 2004

For: INITIATOR DEVICE CAPABLE OF TWO-
WAY HALF-DUPLEX COMMUNICATION
WITH MULTIPLE RECIPIENT DEVICES

Examiner: Shairna Q. Aminzay

Group Art Unit: 2684

Confirmation No.: 3292

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Dear Sir:

This Pre-Appeal Brief responds to the July 5, 2006 Final Office Action. Applicant has filed this Pre-Appeal Brief because of several clear errors in the July 5, 2006 Final Office Action. Please enter the following remarks.

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REMARKS

Claims 28-32 and 34-54 are pending in this application. Applicant respectfully requests reconsideration and reexamination of the pending claims.

1) *Gavette* (U.S. Pat. No. 6,321,095) teaches away from Applicant's invention because *Gavette* would lead a person of ordinary skill in the art in a direction different than the path taken by Applicant

"A reference may be said to teach away when a person of ordinary skill, upon reading the reference, would be discouraged from following the path set out in the reference, or would be led in a direction divergent from the path that was taken by the applicant." *In re Fulton*, 391 F.3d 1195, 1201, 73 U.S.P.Q.2d 1141, 1145 (Fed. Cir. 2004). Applicant's claims recite a half-duplex communication device. However, *Gavette* teaches away from using half-duplex communication because *Gavette* emphasizes several drawbacks of half-duplex communication such as 1) "only one user can talk at a time," 2) "a user must push a 'talk' button to talk to another user," 3) "all participants transmit data on the same channel," 4) all users must "agree upon and select a particular channel to use for a conversation," 5) "communications are generally not private," and 6) "the two-way radios do not provide the call services available with digital systems such as call waiting, caller identification and messaging." (See col. 1, lns. 32-51). *Gavette* criticizes, discredits, and discourages the solution claimed and therefore teaches away from the claimed invention. *Gavette* further emphasizes m-duplex communication "allowing simultaneous bidirectional exchange of information between two or more participants." (See col. 21, lns. 6-8). Hence, upon reading *Gavette*, a person of ordinary skill would be discouraged from following the path set out in *Gavette* to produce a half-duplex communication system due to the large list of drawbacks of half-duplex communication discussed in *Gavette*. Therefore, it is clear error to cite *Gavette* because *Gavette* teaches away from half-duplex communication and would lead a person of ordinary skill in the art in a direction divergent from the path taken by applicant.

2) *Walsh* (U.S. Pat. No. 6,144,848) cannot be combined with *Gavette* because the references teach away from their combination and the combination would render the prior art invention unsatisfactory for its intended purpose

As stated in MPEP § 2145(X)(D)(2), "[i]t is improper to combine references where the references teach away from their combination." Also, if proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 902, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984). *Gavette* discourages half-duplex communication by disclosing its

many drawbacks whereas *Walsh* was cited simply for the teaching of half-duplex communication. These teachings contradict one another and therefore the references teach away from their combination. The Examiner cited *Walsh* for the same teaching as *Fumarolo*, which was cited in the first office action and which was for the teaching of half-duplex communication. Merely substituting *Walsh* in place of *Fumarolo* does not cure the error. Furthermore, if an m-duplex communication system (*Gavette*) were combined with a half-duplex communication system (*Fumarolo* or *Walsh*), then the prior art invention would not work for its intended purpose. Hence, it is clear error to combine *Gavette* with any reference that teaches half-duplex communication. The Examiner erroneously relies on *Gavette* in combination with *Fumarolo* or *Walsh* to reject claims 28-32 and 34-54 under 35 U.S.C. § 103(a).

3) *Gavette* in view of *Walsh* does not teach or suggest that "the acknowledgement information includes the transceiver identification code" (claim 30)

The Examiner cites numerous passages in *Gavette* but none teach or suggest that the acknowledgement information includes the transceiver identification code. Furthermore, *Walsh* does nothing to cure the infirmities of *Gavette*.

Pursuant to claim 30, the control device of the half-duplex communication device transmits its initiator identification code and the transceiver identification code to the transceiver and receives acknowledgement information including the transceiver identification code. That is, the transceiver identification code is transmitted from the initiator half-duplex communication device to the transceiver and from the transceiver back to the initiator half-duplex communication device.

In contrast, *Gavette* discloses a PBS 102 that pages a TMS 104 by placing the MSID of the PBS 102 and the MSID of the TMS 104 on the BCCH slot 314 and receives an acknowledgment to the page on the RACH slot 318 of the circuit 306 (col. 7, ln. 61 to col. 8, ln. 2). *Gavette* does not teach or suggest the TMS 104 transmitting its MSID back to the PBS 102 as its acknowledgement. Rather, the PBS 102 receives an acknowledgment signal from the TMS 104 on a separate slot of the circuit 306. *Gavette* does not disclose, teach or suggest that the acknowledgment signal is the MSID of the TMS 104. Thus, *Gavette* in view of *Walsh* fail to teach or suggest the limitation of claim 30.

Claims 43 and 46 have a similar limitation to that of claim 30. Claim 43 recites that the processor of the initiator communication "receives the transceiver identification code in response to the at least one transceiver determining that the identification code matches its transceiver identification code." Claim 46 recites that the "recipient transceiver . . . automatically transmit, using the available channel, the recipient identification code to the initiator transceiver if the identification code matches the recipient identification code." Hence, *Gavette* in view of *Walsh* fail

to teach or suggest the limitations of claims 43 and 46 for the same reasons advanced above with respect to claim 30.

4) *Gavette* in view of *Walsh* does not teach or suggest that the control device or processor “automatically scan a plurality of channels for an available channel” (claim 31), “scans the plurality of channels for a signal or interference and designates the available channel as a primary channel and another available channel as a standby channel” (claim 36), or “creates an available table that includes a plurality of channel numbers representing the plurality of channels that did not have the signal or interference” (claim 37)

The Examiner cites numerous passages in *Gavette* but none teach or suggest these limitations. Furthermore, *Walsh* does nothing to cure the infirmities of *Gavette*.

According to the invention, the half-duplex communication device, such as an initiator transceiver 100, automatically scans a plurality of channels for an available channel. Since the initiator transceiver 100 is half-duplex, one channel is used for communication between the initiator transceiver 100 and the recipient transceiver 1100 (para. 0031). To locate an available channel, the communication device scans each channel for the presence of any communication or any interference on that channel. If no communication or interference exists, then the particular channel is available (para. 0029). The control device of the half-duplex communication device then creates an available channel table, as shown in Table II (para. 0028). In one embodiment, the control device of the half-duplex communication device scans for 2 available channels and assigns “the lowest channel number in the available channel table as the primary channel (S-520) and the second lowest channel number in the available channel table as the standby channel (S-525)” (para. 0030). “Once the primary and standby channels have been designated, the user of any of the operational transceivers may initiate a call to another transceiver or group of transceivers” (para. 0031).

Gavette does not disclose, teach or suggest automatically scan for an available channel (claim 31). *Gavette* discloses a circuit 306, 308 and 310, divided into seven slots 312 – BCCH slot 314, DCCH slot 316, RACH slot 318, and 4 TCH slots 320, 322, 324, and 326 (col. 5, ln. 33 to col. 6, ln. 5, and Fig. 3). *Gavette* discloses assigning an available TCH slot 320, 322, 324 or 326 for carrying communication session data (col. 5, lns. 58-62). These TCH slots 320, 322, 324, and 326 are on the same frame 303 and not on separate channels. *Gavette* does not scan the slots, since these are predetermined slots on the circuit 306. In contrast, claim 31 recites automatically scan a plurality of channels for an available channel.

Gavette does not disclose, teach or suggest designate primary and standby channels (claim 36). The Examiner erroneously assumes that *Gavette*’s BCCH slot 314 and RACH slot 318 are

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equivalent to the primary and standby channels of claim 36. The BCCH slot 314 and RACH slot 318 are not used for carrying communication data; rather, the BCCH slot 314 is used for synchronization of a communication session while the RACH slot 318 is used for establishing and maintaining communication links (col. 5, lns. 48-56). Furthermore, the Examiner erroneously relies on a "standby message" communicated when a user is deciding "whether to abort a page from PBS 102, to ignore the page from PBS 102 and continue paging the other mobile station, or to accept the page from PBS 102 and continue paging for the other mobile station" (col. 11, lns. 3-13). This "standby message" is not and should not be interpreted as the "standby channel" of claim 36. Such interpretation constitutes clear error.

Gavette does not disclose, teach or suggest create an available channel table (claim 37). Figures 2 and 3 of *Gavette* show a frequency distribution in a frame 303 having multiple circuits 30, 308 and 310. This information is not a tabulation of available channels for communication. Rather, frame 303 represents an information block on one channel, where frequency division multiplexing is utilized for transmitting data simultaneously.

Hence, *Gavette* in view of *Walsh* fail to disclose, teach or suggest the limitations of claims 31, 36, and 37. Claim 46 has a similar limitation to that of claim 31, claims 40, 41, and 51 have a similar limitation to that of claim 36, and claim 52 has a similar limitation to that of claim 37. Hence, claims 40, 41, 46, 51, and 52 are also patentably distinct from *Gavette* in view of *Walsh* for the same reasons advanced above with respect to claims 31, 36, and 37.

For the above reasons, claims 28-32 and 34-54 are in condition for allowance and allowance of the application is hereby solicited. If a telephone interview will assist in prosecution of this application, the undersigned attorney can be contacted at the listed phone number.

I hereby certify that this correspondence is being transmitted via facsimile to the USPTO at 571-273-8300 on August 15, 2006.


Very truly yours,

SNELL & WILMER L.L.P.

By: Lisa Holstein


Signature

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